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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/204,388	12/02/1998	STEVEN JECHA	685.003US1	5458

21186 7590 12/19/2001

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 12/19/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

H.G.

H.G

Office Action Summary

Application No.

09/204,388

Applicant(s)

JECHA ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 62-105 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,247,011. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

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In claim 62 of the instant application, this claim corresponds to claim 1 of '011.

With respect to claim 62 of the instant application, contains the phrase "wherein the prepress software system includes a downloadable document authoring program and at least one prepress translation component, further wherein the downloadable authoring program includes one or more authoring tools ...; wherein the downloaded program executes in a web browser and displays the electronic document in WYSIWYG form to the user, and at least one of the authoring tools has one or more functions that allows a user to select and edit ...; the software system further configured to provide that at least one of the authoring tools is adapted to edit an element of the electronic document ... , and that the electronic document is saved on the server computer system ...; downloading the authoring program form the server computer system to the client computer; the user using at least one authoring tool of the downloaded program at the client computer to edit an element of an electronic document" --- (pages 1 and 2), while on the other hand, claim 1 of '011 contains the phrases "one or more authoring tools" ... , "at least one downloaded authoring tool is a program ... and has one or more functions that can be used to create an electronic document ..., and allow a user to select and edit ...". However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to the modify '011 to arrive at claim 62 of the instant application, by simply including downloading at least one authoring tool to create an electronic document and to perform the steps of claim 62 of the instant application. The scope of claim 1 of the '011 patent reference encompasses all of the

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elements of the instant claim 62 except the “downloading at least one authoring tool to create an electronic document.”

With respect to claims 63-65 which depends on claim 62, contains the phrases “Internet, Intranet, and Extranet. However it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ‘011 patent to arrive at the claim 62 of the instant application, by simply including an Internet, Intranet, and Extranet.

With respect to claims 66-77 of the instant application, these claims have essentially the same claim elements as claims 2-13 of the ‘011 patent.

With respect to claim 78 of the instant application, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the ‘011 patent to arrive at claim 78 of the instant application, by simply having an electronic mail that is MIME-compliant which is well known in the art of electronic mails for the electronic mail to be in a certain format for it to be printed by the user when it is transmitted over the Internet to be a MIME type file.

With respect to claim 79 of the instant application, this claim has essentially the same claim elements as those of claim 1 of the ‘011 patent.

With respect to claims 80-85 and 87-89 of the instant application, these claims contain the phrases “browser, Internet, Intranet, and Extranet” making it obvious to one of ordinary skill in the art at the time the invention was made to modify the “011 patent to arrive at claims 80-85 and 87-89.

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With respect to claims 86 and 90-93 of the instant application, these claims contain essentially the same claim elements as claims 16-20 of the '011 patent.

With respect to claim 94 of the instant application, contains phrases "printer, server, and electronic mail." It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in the '011 patent to arrive at claim 94 since the claims contain "a printing device" in claim 1, col. 9, line 2 and "a server" in claims 1-3, 7, 13-15, 21, and 27-29, by simply including the steps of claim 94 in the claims of the '011 patent.

With respect to claim 95 of the instant application, this claim contains essentially the same claim elements as claims 1, 14, and 21 of the '011 patent.

With respect to claims 96-100 of the instant application, these claims contain essentially the same elements as claims 22-26 of the '011 patent.

With respect to claims 101-104 of the instant application, these claims contain essentially the same elements as claims 1, 14, 21, 28, and 29 of the '011 patent.

With respect to claims 104 and 105 of the instant application, these claims contain essentially the same claim elements as claims 21-29 of the '011 patent.

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INQUIRIES

3. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ms. Ella Colbert whose telephone number is (703) 308-7064. The Examiner can normally be reached Monday through Friday from 6:30 a.m. to 3:00 p.m. EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kim Vu, can be reached on (703)305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703)746-7238 (for After Final) and (703)746-7239 (for formal communications intended for entry).

Or:

(703)746-7240 (for informal or draft communications, please label

"PROPOSED" or **"DRAFT"**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Virginia., Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group Receptionist whose telephone number is (703)305-3900.



E. Colbert

December 15, 2001



HOSAINT T. ALAM
PRIMARY EXAMINER